

### REMARKS

Initially, Applicants have amended claims 212, 214, 223, 259, 277-279, 286-293, 295-296, and 298 to more accurately claim the present invention and not for any  
5 reason related to patentability. No new matter has been added. Applicants believe that the following comments overcome the rejections set forth in the March 3, 2003 Office Action and that the rejections should be withdrawn.

#### 10 I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed commercial document. Also, the machine recognizable  
15 feature may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. When a machine recognizable feature is recognized, an electronic signal is transmitted for processing. The  
20 processing results in the display of programming material related to the information contained in the printed commercial document. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the printed

commercial document to supplement the information provided by the printed commercial document.

## II. THE EXAMINER'S REJECTIONS

### 5        A.    35 U.S.C. § 102(b)

The Examiner rejected claims 168, 249, 293, and 296 under 35 U.S.C. § 102(b) as being anticipated by Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall"). Initially, the Examiner argued that  
10 Withnall discloses a transport system having a microprocessor-based, optical ticket reader that reads information from a printed ticket to determine and display the validity of the ticket. Also, the Examiner explained that a microprocessor-based ticket printer is used to issue  
15 bar-coded tickets. The Examiner then indicated that reference information is stored in memory which communicates with the ticket-checking means. The Examiner concluded therefrom that Withnall discloses the invention claimed in claims 168, 249, 293, and 296.

### 20        B.    35 U.S.C. § 103(a)

The Examiner rejected claims 170-197 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (March 3, 2003 Office Action Summary, p. 5). The Examiner admitted

that the rejected claims differ from Withnall for disclosing various commercial documents. The Examiner contended that all of these differences would have been obvious variations of Withnall.

5 To support the aforementioned conclusion, the Examiner cited Cassannas et al. U.S. Patent No. 4,492,164 (hereinafter referred to as "Cassannas"), Norman, Jr. U.S. Patent No. 5,126,547 (hereinafter referred to as "Norman"), and Drillick U.S. Patent No. 4,813,350 (hereinafter  
10 referred to as "Drillick"). The Examiner specifically cited Cassannas for describing cheques, bills for exchange, order forms, and bills to be protested. Norman was cited for describing checks, drafts, credit card receipts, and bank deposit slips. Finally, the Examiner cited Drillick  
15 for describing checks, invoice forms, and money orders.

Next, the Examiner rejected claims 198-223 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the prior art of record." (March 3, 2003 Office Action Summary, p. 6). The Examiner  
20 admitted that Withnall fails to disclose a data link that carries certain types of data and video images, which the Examiner believed to be obvious. For evidence, the Examiner cited Thacher et al. U.S. Patent No. 5,083,271 (hereinafter referred to as "Thacher"), Ertz et al. U.S.

Patent No. 5,003,577 (hereinafter referred to as "Ertz"), and Plummer U.S. Patent No. 4,992,824 (hereinafter referred to as "Plummer"). Thacher and Ertz were cited for describing various data links. Also, Plummer was cited for  
5 disclosing data links that transmit image and video information.

Additionally, the Examiner rejected claims 225-248, 295, and 298 under 35 U.S.C. § 103(a) as being unpatentable over Withnall "in view of the general teachings of the  
10 prior art of record." (March 3, 2003 Office Action Summary, p. 7). The Examiner admitted that Withnall fails to disclose watermarks, invisible bar codes, magnetic codes, printed characters, and invisible icons. The Examiner took Official Notice that the use of these features as a data  
15 input source was known. For support, the Examiner cited Konishi et al. U.S. Patent No. 5,237,156 (hereinafter referred to as "Konishi") and Younger U.S. Patent No. 5,151,687 (hereinafter referred to as "Younger"). The Examiner cited Konishi for disclosing a scanner for bar  
20 codes, magnetic characters, and character recognition. Younger was cited for acknowledging several types of "media-taped" materials.

Subsequently, the Examiner rejected claims 249-261, 294, and 297 under 35 U.S.C. § 103(a) as being unpatentable

over Withnall and common knowledge in the art. The Examiner admitted that Withnall differed from the claims for not encoding various information in machine recognizable indicia, which the Examiner asserted to be  
5 obvious. The Examiner also noted that:

10 "a Court has decided that printed matter such as encoding particular information in a code, etc., would not be given patentable weight (In re Gulack, 217, U.S.P.Q. 401)." (March 3, 2003 Office Action, p. 8).

Also, the Examiner rejected claims 262-276 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ishii et al. U.S. Patent No. 5,148,297 (hereinafter  
15 referred to as "Ishii"). The Examiner admitted that Withnall does not disclose certain claimed display devices. The Examiner then took Official Notice that the use of certain display devices was known. As evidence, Ishii is disclosed for providing a liquid crystal display ("LCD").

20 Next, the Examiner rejected claims 277-292 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Although the Examiner admitted that Withnall fails to disclose certain code recognition devices, the Examiner took Official Notice that  
25 the use of such devices was old.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168, 249, 293, and 296 under 35 U.S.C. § 102(b) as being anticipated by Withnall. Applicants respectfully disagree. Specifically, Withnall does not disclose the programming material of the claimed invention. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning a printed commercial document. Withnall, on the other hand, scans a commuter ticket to ascertain a validity state associated with that ticket. However, at no point does Withnall provide more substantial programming material which includes various supplemental information corresponding to the printed commercial document. Therefore, Applicants respectfully submit that Withnall does not disclose each and every element of claims 168, 249, 293, and 296 and therefore, does not anticipate these claims.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 249-261, 294, and 297 under 35 U.S.C. § 103(a) as being unpatentable over

Withnall and common knowledge in the art. Also, the Examiner rejected claims 277-292 under 35 U.S.C. § 103(a) as being unpatentable over Withnall and common knowledge in the art. Applicants respectfully disagree with both of  
5 these rejections. As argued above for the Examiner's rejection under 35 U.S.C. § 102(b), Withnall does not disclose any programming material. Regardless of whether any of the features indicated by the Examiner are obvious, Withnall still fails to disclose the unobvious programming  
10 material of the present invention, and therefore, these rejected claims cannot be unpatentable over Withnall and common knowledge in the art.

Also, the Examiner rejected claims 170-197 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view  
15 of Cassannas, Norman, and Drillick. Next, the Examiner rejected claims 198-223 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Thacher, Ertz, and Plummer. Additionally, the Examiner rejected claims 225-248, 295, and 298 under 35 U.S.C. § 103(a) as being  
20 unpatentable over Withnall in view of Konishi and Younger. Also, the Examiner rejected claims 262-276 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Ishii.

Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of the references cited against them. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that there is no suggestion or motivation to modify or combine Withnall with any of the aforementioned references.

"Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (Emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall with the



aforementioned references to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has not pointed to what motivation is provided by the references themselves. Applicants submit that no  
5 combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention, especially because no motivation or suggestion for combining these references exist within the references themselves. Specifically, Withnall discloses a system for  
10 easing the examination of commuter tickets for validity. This purpose is far removed from the intent of Cassannas' printer that utilizes a platen roller, which prints via a stamp onto an information carrier. Withnall also relates in no way to Norman, which discloses checks having two  
15 strips that disclose machine readable account information. Additionally, Withnall has no apparent relation to Drillick which discloses an apparatus for imprinting characters on financial documents. Also, Withnall has no apparent connection to Thacher which discloses a scoring system for  
20 video game tournaments. Withnall also has no clear connection with Ertz's interface between a video terminal and a voicemail system. Additionally, Withnall does not relate in any way to Plummer's system for printing on a photosensitive film via an LCD. Moreover, Withnall lacks

relation to Konishi's apparatus for reading index information from images for expediting image registration. In addition, Withnall does not show any relation to Younger, which discloses an apparatus that logs information  
5 pertinent to "media-taped" material. Finally, there is no relation between Withnall and Ishii, which discloses an LCD that provides better image quality when viewed at an angle. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the  
10 art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, with any features of the aforementioned references.

15       Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejections actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v.  
20 Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co.

v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193,  
199 (Fed. Cir. 1983):

5 "It is wrong to use the patent in suit as a guide  
through the maze of prior art references,  
combining the right references in the right way  
so as to achieve the result of the claim in suit.  
Monday morning quarterbacking is quite improper  
when resolving the question of nonobviousness in  
a court of law."

10 Applicants submit that the only suggestion or  
motivation for the Examiner's combination of references is  
provided by the teachings of Applicants' disclosure. No  
such suggestion or motivation is provided by the references  
15 themselves; nor could there be in view of the difference in  
subject matter and the corresponding goals thereof.

In view of the foregoing, base claims 168, 293, and  
296 cannot be unpatentable over any combination of Withnall  
and the aforementioned references. The remaining rejected  
20 claims are dependent on these claims and contain all of the  
limitations of their respective base claims. Therefore,  
these dependent claims are also not unpatentable over these  
references.




CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and  
5 favorable action is accordingly solicited.

Respectfully submitted,

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